IN THE DRAWING FIGURES:

Kindly substitute Figures 1-12 of the above-identified application with the enclosed twelve (12) sheets of formal drawings of Figures 1-12, each sheet marked "REPLACEMENT SHEET".

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested.

Claims 1-23, 25, 26, 28-48, 97-112 and 169-172 are currently pending, wherein claims 1, 11, 20, 22, 28, 38, 47, and 169-172 are independent. Claims 24, 27, 49-96 and 113-168 have been canceled. Claims 1, 4, 5, 11, 14, 20, 28, 31, 32, 38, 41 and 47 have been amended. Support for these amendments can be found at least in Figures 3 and 5, page 7, lines 1-22, and page 8, lines 8-32 of the present application. No new matter has been introduced by way of these amendments.

Applicant notes with appreciation the acceptance by the Patent Office of the drawings filed on September 11, 2000.

In the first section of the Office Action, the Patent Office objects to the drawings of the present application and asserts that new corrected drawings are required, because the text legends are allegedly small and difficult to read. The Patent Office also asserts that the replacement sheet for Figure 1 should include a printed legend showing that it is prior art. Applicant hereby submits twelve (12) sheets of formal drawings for Figures 1-12 for review by the Patent Office in connection with the above-identified application, each sheet marked "REPLACEMENT SHEET." Should the enclosed drawings require changes, it is respectfully requested that the Patent Office notify the undersigned of same.

Accordingly, reconsideration and withdrawal of these grounds of objection are respectfully requested.

In the third section of the Office Action, claim 11 is objected to, because of

informalities. The Patent Office asserts that the word "used" should read "uses." This

objection is respectfully traversed.

According to M.P.E.P. § 2173.02,

[t]he examiner's focus during examination of claims for compliance with the
requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether
the claim meets the threshold requirements of clarity and precision, *not*
whether more suitable language or modes of expression are available. . . .
Some latitude in the manner of expression and the aptness of terms should be
permitted even though the claim language is not as precise as the examiner
might desire. Examiners are encouraged to suggest claim language to
applicants to improve the clarity or precision of the language used, *but should*
not reject claims or insist on their own preferences if other modes of
expression selected by applicants satisfy the statutory requirement. [M.P.E.P.
§ 2173.02 (emphasis added)]

Given the "latitude in the manner of expression and the aptness of terms" afforded to the

Applicant, it is respectfully submitted that the aforementioned claim is clear and precise and

fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Applicant

respectfully submits that there is no statutory basis for the objections to the claims based on

"informalities."

However, merely to facilitate prosecution in the present application, Applicant hereby

amends claim 11 to address the aforementioned informality. This amendment is made

merely to correct a minor typographical error, and is not made for any purpose related to

patentability or to satisfy any statutory requirement. This amendment does not narrow or

otherwise limit the scope of the claim. No new matter has been introduced by way of this

amendment.

Accordingly, reconsideration and withdrawal of this ground of objection is

respectfully requested.

It is noted that the Patent Office alleges that "should claim 47 be found allowable,

claim 95 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof."

[Office Action, page 3] Applicant hereby cancels claims 95 and 96.

In the fourth section of the Office Action, claim 172 is rejected under 35 U.S.C.

§ 101, because the claimed invention is allegedly directed to non-statutory subject matter.

This rejection is respectfully traversed.

The Patent Office merely states that "[c]laim 172 is directed to a computer program

that is not embodied within a computer-readable medium." [Office Action, page 4]

However, it is respectfully noted that according to M.P.E.P. § 2106, "[t]he claimed invention

as a whole must accomplish a practical application. That is, it must produce a 'useful,

concrete and tangible result.'" [M.P.E.P. § 2106 (citations omitted)] Applicant notes that on

October 26, 2005, the Patent Office issued "Interim Guidelines for Examination of Patent

Applications for Patent Subject Matter Eligibility" (hereinafter, the "Guidelines"). These

Guidelines "set forth the procedures USPTO personnel will follow when examining

applications." [Guidelines, page 2] According to the Guidelines, the proper test for

determining whether claims are directed to statutory subject matter is whether the claimed

process produces a useful, tangible and concrete result, i.e., apply the practical application

test set forth in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47

U.S.P.Q.2d 1596 (Fed. Cir. 1998). The attention of the Patent Office is directed to pages 19-

22 of the Guidelines, which discusses proper application of the appropriate tests under 35

U.S.C. § 101.

It is respectfully submitted that the Patent Office has failed to apply the correct test

for utility required under 35 U.S.C. § 101, i.e., the practical application test set forth in *State*

Street Bank. It is respectfully submitted that claim 172 is directed to a computer program for

playing and recording media data from a media player/recorder that produces a useful,

concrete and tangible result by "(c) <u>outputting the first portions of the at least one of the</u>

<u>plurality of sections of the media data from the memory</u>, wherein when a user selects a

particular one of said plurality of selections, then retrieving a remaining portion of the

particular one of said plurality of selections and then <u>outputting the portion and remaining</u>

<u>portion the particular one of said plurality of selections</u>."

Therefore, Applicant respectfully submits that the subject matter of claim 172 is

statutory under 35 U.S.C. § 101. Accordingly, reconsideration and withdrawal of these

grounds of rejection are respectfully requested.

In the fifth section of the Office Action, claims 1-4, 6, 9, 11-13, 15, 18, 22, 23, 28-31,

33, 36, 38, 97, 98, 100, 101, 104-107, 109, 110 and 169-172 are rejected under 35 U.S.C.

§ 102(e) as allegedly being anticipated by Birrell et al. (U.S. Patent No. 6,332,175,

hereinafter "Birrell"). These rejections are respectfully traversed.

Conventional media players include separate processors for performing decoding and

hard disk controlling. Processing is generally done sequentially, with little overlap. For

example, a first processor can control the reading of a block of data from a hard disk. Once

read, the first processor and hard disk are shut down. A second processor then can perform

the decoding of the data. Thus, one processor will generally be working while the other is

not, as they are run at alternate times. In addition, the use of multiple processors requires

greater energy, a larger die area, and, therefore, increased manufacturing costs. Furthermore,

each processor may require the payment of licensing fees to the third-party manufacturer for

use of that processor, so that the use of more processors would require the payment of more licensing fees.

Exemplary embodiments of the present invention are directed to a media player/recorder. As recited in, for example, independent claim 1 of the present application, the media player/recorder includes a programmable processor that is programmed as a **storage controller** to retrieve the compressed media data stored in a storage device. The programmable processor is <u>also</u> programmed as a **digital signal processor** to decompress the compressed media data stored in a memory. By combining such functionality into a single device (the programmable processor), an apparatus including the media/player recorder can be fabricated at lower cost and have lower energy consumption. [*see* present application, page 8, lines 1-2] Thus, exemplary embodiments of the present invention use a single programmable processor to perform multiple functions. Using a single programmable processor results in a reduction in energy consumption and utilization of space (since there is a fewer number of chips used), a corresponding decrease in manufacturing costs, and a potential reduction in licensing fees.

As understood by Applicant, Birrell is directed to a portable audio player that stores a large amount of compressed audio data on an internal disk drive, and loads a portion of this into an internal random access memory (RAM) which is said to require less power and less time to access. The audio player plays the data stored in RAM and monitors the amount of unplayed data. When the amount of unplayed data falls below a threshold, additional data is copied from the disk drive into RAM. Because the time necessary to copy a block of data from the disk drive to RAM is much less than the amount of time it takes to play the same block of audio data from RAM, the approach minimizes the amount of time that the disk

drive must be operated, and thus minimizes the amount of power consumed by the system.

[*see* Birrell, Abstract] As illustrated in Figure 1, the portable audio player 100 includes

numerous discrete components, including a data processor 102, a disk 104 and associated

disk controller 106, a ROM 112 and digital-to-analog converter 126. [*see* Birrell, column 4,

lines 29 and Figure 1]

More particularly, as taught by Birrell, the data processor 102 "decompresses a

portion a portion of the audio data stored in RAM 108." [Birrell, column 4, lines 31-32]

However, as illustrated in Figure 1 of Birrell, the disk controller 106 is a separate, discrete

component of the portable audio player 100. As illustrated in Figure 2B of Birrell, the

control programs that can be stored in ROM and executed by the processor 102 include: a set

of user interface procedures 160; a play procedure 166, a decompression procedure 168, a

power down procedure 170; a power up procedure 172; and control procedures for

implementing fast forward 176, rewind 178, track scanning 180. [*see* Birrell, column 5, lines

9-33] It is respectfully submitted that nowhere does Birrell teach the feature of a

programmable processor that is programmed as **both** a **storage controller** to retrieve the

compressed media data stored in a storage device **and** a **digital signal processor** to

decompress the compressed media data stored in a memory. In particular, nowhere does

Birrell teach that any of the "control programs" executed by the data processor 102 includes a

storage controller to retrieve the compressed media data stored in a storage device, as

recited in, for example, independent claim 1 of the present invention. For at least these

reasons, it is respectfully submitted that Birrell does not anticipate the subject matter of

independent claim 1.

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Independent claims 11, 22, 28 and 38 recite features similar to those recited in independent claim 1, and are, therefore, patentably distinguishable over Birrell for at least those reasons stated above with regard to claim 1.

With respect to the rejection of claims 169-172, it is respectfully submitted that nowhere does Birrell teach the features of a processor to transfer <u>first portions</u> of at least one of the plurality of selections of the media data from said storage device to said memory; and an output device, wherein said output device outputs the <u>first portions</u> of the at least one of the plurality of sections of the media data from the memory, and wherein when a user selects a particular one of said plurality of selections, said processor retrieves a <u>remaining portion of the particular one of said plurality of selections</u> and said output device outputs the <u>portion and remaining portion the particular one of said plurality of selections</u>, as recited in, for example, independent claim 169 of the present application.

As illustrated in Figure 12 of the present application, instead of retrieving just one selection, first portions of multiple selections can be transferred from disk drive 230 to memory 202. When the user starts playing back the selection, a timer is started (step 1208) and the first selection is played back (step 1210). If a user instruction is received (step 1212) to continue playing that selection is received within a predetermined time (step 1214), the remaining portion of the selection is transferred from disk drive 230 to memory 202 (step 1216) for continued play back (step 1218). If the timer times out (step 1214), the first portion of the next selection (step 1206) is played back and the process is repeated for each remaining first portion. [see present application, page 11, line 30 – page 12, line 6]

In contrast to exemplary embodiments of the present invention, Birrell teaches that

[p]lay control logic monitors (222) the amount of data that remains in RAM (or equivalently, it monitors the amount of playtime associated with the unplayed data in RAM). To ensure that there is no undesirable break in the audio output, when the playtime associated with the data stored in RAM falls below a predetermined threshold (sometimes called the low water mark), the play control logic determines whether, and how much, additional data will be required by RAM 108, and initiates the transfer of additional data from disk 104 to RAM 108 (224). To transfer data from disk 104 to RAM 108, the play control logic powers on the hard disk, copies data to RAM 108, then powers off the disk 104. The threshold at which data will be copied from disk 104 to RAM 108 will depend on the playtime of the data remaining in RAM 108 and the time required to access disk 104 and transfer data to RAM 108. To ensure that an undesirable break in the audio output does not occur, the threshold should be chosen so that RAM 108 does not run out of data to play before additional data is copied into it from the disk 104. [Birrell, column 6, lines 5-23 (emphasis added)]

Thus, according to Birrell, data is merely transferred from disk 104 to RAM 108 to replenish the RAM 108 when the amount of data in RAM 108 falls below the "low water mark." It is respectfully submitted that nowhere does Birrell teach the feature of the processor retrieving a remaining portion of the particular one of the plurality of selections and the output device outputs the portion and remaining portion of the particular one of said plurality of selections, when a user selects a particular one of said plurality of selections. Birrell merely teaches that the RAM 108 is replenished when the amount of data in RAM 108 falls below a predetermined threshold. For at least these reasons, it is respectfully submitted that Birrell does not anticipate the subject matter of independent claim 169.

Independent claims 168-172 recite features similar to those recited in independent claim 169, and are, therefore, patentably distinguishable over Birrell for at least those reasons stated above with regard to claim 169.

Dependent claims 2-4, 6, 9, 12, 13, 15, 18, 23, 29-31, 33, 36, 97, 98, 100, 101, 104-107, 109 and 110 variously depend from independent claims 1, 11, 22, 28 and 38, and are,

therefore, patentably distinguishable over Birrell for least those reasons stated above with regard to claim 1, 11, 22, 28 and 38.

For at least the foregoing reasons, it is respectfully submitted that Birrell does not anticipate the subject matter of claims 1-4, 6, 9, 11-13, 15, 18, 22, 23, 28-31, 33, 36, 38, 97, 98, 100, 101, 104-107, 109, 110 and 169-172. Accordingly, reconsideration and withdrawal of these grounds of rejection are respectfully requested.

In the sixth section of the Office Action, claims 7, 16, 34 and 43 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Birrell. These rejections are respectfully traversed.

Dependent claims 7, 16, 34 and 43 variously depend from independent claims 1, 11, 28 and 38, and are, therefore, patentably distinguishable over Birrell for at least those reasons stated above with regard to independent claims 1, 11, 28 and 38. Accordingly, reconsideration and withdrawal of these grounds of rejection are respectfully requested.

In the seventh section of the Office Action, claims 5, 14, 20, 32, 41, 47, 99, 102, 103, 108, 111 and 112 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Birrell in view of Gadre et al. (U.S. Patent No. 6,308,253, hereinafter "Gadre"). These rejections are respectfully traversed.

It is respectfully submitted that neither Birrell nor Gadre teach or suggest the feature of an integrated circuit to control a media player/recorder, in which the integrated circuit includes a programmable processor that is programmed as a **digital signal processor**, a **storage controller, and** a **read channel**, as recited in, for example, independent claim 20 of the present application.

As discussed previously, Birrell does not teach or suggest a programmable processor

that is programmed as **both** a **storage controller** <u>and</u> a **digital signal processor** to

decompress the compressed media data stored in a memory. Additionally, it is noted that the

Patent Office <u>acknowledges</u> that Birrell "does not disclose these elements within the

processor as a single integrated circuit." [Office Action, page 11] Furthermore, as illustrated

in Figure 3 of the present application, read channel 341 "encodes the write data under the

control of DSP/MPU 343, and supplies the encoded write data to preamplifier 232." [present

application, page 8, lines 18-20] Read channel 341 also "decodes the read data under the

control of DSP/MPU 343, and generates read data." [present application, page 8, lines 28-29]

In contrast to the feature of a read channel configured to <u>read</u> the compressed media data

from the storage device, it is respectfully noted that Birrell merely teaches one or more

internal buses 134 for interconnecting the elements illustrated in Figure 1 of Birrell.

As understand by Applicant, Gadre is directed to a reduced programmable controller

for an extensible digital signal processing architecture that supports particular instructions to

facilitate common digital signal processing (DSP) operations. [*see* Gadre, Abstract]

According to Gadre, various DSP functions or operations are allocated between multiple

processing cores disposed on an integrated circuit device. [*see* Birrell, column 2, line 67 –

column 3, line 2] "Each processing core includes a very small CPU, known as a

programmable controller, which is a reduced instruction set (RISC) processor supporting a

small number of useful instructions for digital signal processing." [Gadre, column 3, lines 2-

5] Thus, according to Gadre, the functionality of multiple DSP chips is integrated onto the

same integrated circuit device. [*see* Gadre, column 1, lines 55-57] Such DSP functionality

includes video encoding/decoding, audio encoding/decoding, and

multiplexing/demultiplexing. [*see* Gadre, column 5, lines 16-53] In general, the integrated

DSP devices can support a wide variety of additional DSP operations, including "filtering,

decoding, image processing, effect processing, bit manipulation, stream parsing and related

operations." [Gadre, column 5, lines 55-58]

Thus, Gadre merely teaches the integration of DSP and DSP-related functions into an

integrated device. Contrary to the assertions of the Patent Office, it is respectfully submitted

that nowhere does Gadre teach or even suggest the feature of an integrated circuit comprising

a programmable processor that is programmed as a **digital signal processor** to control a

storage device, a **storage controller** responsive to the digital signal processor, **and** a **read**

channel responsive to the storage controller to read the compressed media data from the

storage device. Consequently, it is respectfully submitted that Gadre does not address the

above-identified deficiencies of Birrell.

For at least the foregoing reasons, it is respectfully submitted that Birrell and Gadre,

whether considered alone or in combination, do not teach or suggest numerous features of the

present invention, as recited in, for example, independent claim 20 of the present application.

Accordingly, it is respectfully submitted that the combination of Birrell and Gadre does not

render the subject matter of independent claim 20 obvious.

Independent claim 47 recite features similar to those recited in independent claim 20,

and is, therefore, patentably distinguishable over the combination of Birrell and Gadre for at

least those reasons stated above with regard to claim 20.

Dependent claims 5, 14, 32 and 41 variously depend from independent claims 1, 11,

28 and 38, and are, therefore, patentably distinguishable over the combination of Birrell and

Gadre for at least those reasons stated above with regard to independent claims 1, 11, 28 and

38.

For example, it is noted that the Patent Office acknowledges that Birrell "does not

disclose these elements within the processor as a single integrated circuit." [Office Action,

page 11] As discussed previously, it is also respectfully submitted that Birrell does not teach

the feature of a read channel configured to read data from the storage device, as recited in, for

example, dependent claim 5 of the present application. Furthermore, it is respectfully

submitted that nowhere does Gadre teach or even suggest the feature of a programmable

processor that is programmed as **both a storage controller** to retrieve the compressed media

data stored in a storage device **and** a **digital signal processor** to decompress the compressed

media data stored in a memory. Therefore, Gadre does not address the above-identified

deficiencies of Birrell.

For at least the foregoing reasons, it is respectfully submitted that Birrell and Gadre,

whether considered alone or in combination, do not teach or suggest numerous features of the

present invention, as recited in, for example, dependent claim 5 of the present application.

Accordingly, it is respectfully submitted that the combination of Birrell and Gadre does not

render the subject matter of dependent claim 5 obvious.

Dependent claims 14, 32 and 41 recite features similar to those recited in dependent

claim 5, and is, therefore, patentably distinguishable over the combination of Birrell and

Gadre for at least those reasons stated above with regard to dependent claim 5.

Dependent claims 99, 102, 103, 108, 111 and 112 variously depend from independent

claims 1, 11, 20, 28, 38 and 47, and are, therefore, patentably distinguishable over the

combination of Birrell and Gadre for at least those reasons stated above with regard to independent claims 1, 11, 20, 28, 38 and 47.

Additionally, according to established mandates of the patent laws, "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." [M.P.E.P. § 2142] "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." [M.P.E.P. § 2143.01] "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." [*In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000)] The showing must be "clear and particular, and it must be supported by **actual evidence**." [*Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added)] It is not sufficient to rely on "common sense and common knowledge," as there must be specific evidence to support the motivation. [*See In re Lee*, 277 F.3d. 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002)]

It is respectfully submitted that the Patent Office has made no showing of a motivation to combine based on actual, specific, evidence. With respect to the combination of Birrell with Gadre, the Patent Office asserts that a skilled artisan would have been motivated to implement the elements of Birrell on a single chip in the manner taught by Gadre "to achieve greater performance, lower design and manufacturing costs, reduced

component size, and reduced power requirements." [Office Action, page 11 – page 12] It is

respectfully submitted that none of the references relied upon by the Patent Office suggest

that the portable audio player of Birrell would be improved by the integration of DSP and

DSP-related functions onto the same integrated circuit device as taught by Gadre. The Patent

Office's alleged motivation is simply a bald, naked assertion, completely unsupported by any

actual, specific, evidence. Consequently, it is respectfully submitted that the Patent Office

has not established a *prima facie* case of obviousness.

Rather, according to M.P.E.P. § 2142, "[t]o reach a proper determination under 35

U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of

obviousness] must be reached on the basis of the facts gleaned from the prior art."

Furthermore, according to M.P.E.P. § 2143.01, "[t]he mere fact that references can be . . .

modified does not render the resultant combination obvious unless the prior art also suggests

the desirability of [such modification]." [*citing* In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430

(Fed. Cir. 1990)] Since the Patent Office has offered no proper support or motivation for

combining the references, it is respectfully submitted that the rejection based on obviousness

is clearly and unequivocally founded upon "knowledge gleaned only from applicant's

disclosure." [*see* M.P.E.P. § 2145] Consequently, it is respectfully submitted that the

rejection entails hindsight and is, therefore, improper.

For at least the foregoing reasons, it is respectfully submitted that the combination of

Birrell and Gadre does not render the subject matter of claims 5, 14, 20, 32, 41, 47, 99, 102,

103, 108, 111 and 112 obvious. Accordingly, reconsideration and withdrawal of these

grounds of rejection are respectfully requested.

In the eighth section of the Office Action, claims 8, 17, 21, 25, 35, 44, 48 and 96 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Birrell in view of Yanagihara et al. (U.S. Patent No. 6,233,393, hereinafter "Yanagihara"). These rejections are respectfully traversed.

Dependent claims 8, 17, 35 and 44 variously depend from independent claims 1, 11, 28 and 38, and are, therefore, patentably distinguishable over the combination of Birrell and Yanagihara for at least those reasons stated above with regard to independent claims 1, 11, 28 and 38.

For example, it is noted that the Patent Office acknowledges that "Birrell does not explicitly disclose wherein said digital signal processor determined a compression format of the media data stored in said memory and retrieving the process in accordance with the determined compression format." [Office Action, page 15]

It is respectfully submitted that Yanagihara does not teach or even suggest the feature of a programmable processor that is programmed as **both** a **storage controller** to retrieve the compressed media data stored in the storage device, **and** a **digital signal processor** to decompress the compressed media data stored in memory.

Furthermore, Yanagihara merely teaches that

general control data may include general information pertaining to a stream of data (such as, the type of broadcast system (NTSC, PAL), the type of compression mode, and so forth) and parental information. The general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received general control data. For example, the general controller section 21 may determine the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM) to be regenerated or reproduced from the general control data. [Yanagihara, column 2, lines 6-16]

Contrary to the assertions of the Patent Office, nowhere does Yanagihara teach or suggest the feature that the digital signal processor determines a compression format of the media data stored in memory, wherein the process for decompressing compressed data is retrieved from the storage device in accordance with the determined compression format, and wherein the media data is decompressed in accordance with the retrieved process, as recited in, for example, dependent claim 8 of the present application. It is noted that the Patent Office has not even attempted to proffer a citation to Yanagihara that evinces such a feature. [*see* Office Action, page 15] Therefore, Yanagihara does not address the above-identified deficiencies of Birrell.

Dependent claims 17, 35 and 44 recite features similar to those recited in dependent claim 8, and are, therefore, patentably distinguishable over the combination of Birrell and Yanagihara for at least those reasons stated above with regard to dependent claim 8.

Dependent claims 21, 25 and 48 variously depend from independent claims 20 and 47, and are, therefore, patentably distinguishable over the combination of Birrell and Yanagihara for at least those reasons stated above with regard to independent claims 20 and 47.

For example, it is noted that the Patent Office acknowledges that Birrell "does not explicitly discloses [sic] storing the process on the storage device as claimed in claim 21." [Office Action, page 16] Additionally, the Patent Office also acknowledges that "Birrell does not explicitly disclose wherein said digital signal processor determines a compression format of the media data stored in said memory and retrieving the process in accordance with the determined compression format." [Office Action, page 17]

As discussed previously, <u>nowhere</u> does Yanagihara teach or suggest the feature that the digital signal processor determines a compression format of the media data stored in memory, wherein the process for decompressing compressed data is retrieved from the storage device in accordance with the determined compression format, and wherein the media data is decompressed in accordance with the retrieved process, as recited in, for example, dependent claim 21 of the present application. It is noted that the Patent Office has again not even attempted to proffer a citation to Yanagihara that evinces such a feature. [*see* Office Action, page 17] Therefore, Yanagihara does not address the above-identified deficiencies of Birrell.

Dependent claims 25 and 48 recite features similar to those recited in dependent claim 21, and are, therefore, patentably distinguishable over the combination of Birrell and Yanagihara for at least those reasons stated above with regard to dependent claim 21.

Additionally, it is respectfully submitted the Patent Office has provided no reference, citation or other actual evidence, in Birrell, Yanagihara or otherwise, for combining the references in the manner suggested by the Patent Office. Accordingly, it is respectfully submitted that the Patent Office has failed to establish a *prima facie* case of obviousness. Rather, it is respectfully submitted that the rejection based on obviousness is wholly and completely founded upon "knowledge gleaned only from applicant's disclosure." [*see* M.P.E.P. § 2145] Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper.

Accordingly, reconsideration and withdrawal of these grounds of rejection of claims 8, 17, 21, 25, 35, 44, 48 and 96 are respectfully requested.

Applicant notes that the Patent Office has taken Official Notice that "it would have

been obvious to one of ordinary skill in the art at the time of the invention to store the

procedures in the ROM instead of in the storage device." [Office Action, pages 10 and 16]

Applicant respectfully traverses the assertion of Official Notice. According to M.P.E.P. §

2144.03, "[t]he examiner may take official notice of facts outside of the record which are

capable of instant and unquestionable demonstration as being 'well-known' in the art." In

other words, official notice may be taken "[i]f the knowledge [outside of the record] is of . . .

notorious character." [M.P.E.P. § 2144.03] Furthermore, "[i]f the applicant traverses such an

assertion the examiner should cite a reference in support of his or her position." [M.P.E.P. §

2144.03] Pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of Official

Notice and respectfully requests that the Patent Office cite a document which teaches such an

allegedly "instant and unquestionable" fact so that the Applicant has a full and fair

opportunity to respond to the combination of documents.

Alternatively, according to M.P.E.P. § 2144.03,

> [a]ny rejection based on assertions that a fact is well-known or is common
> knowledge in the art without documentary evidence to support the examiner's
> conclusion should be judiciously applied. Furthermore, . . . any facts so
> noticed should be of notorious character and serve only to "fill in the gaps" in
> an insubstantial manner which might exist in the evidentiary showing made by
> the examiner to support a particular ground of rejection. It is *never*
> appropriate to rely solely on common knowledge in the art without
> evidentiary support in the record as the principal evidence upon which a
> rejection was based. [M.P.E.P. § 2144.03 (emphasis added)]

Thus, "if the examiner is relying on personal knowledge to support the finding of what is

known in the art, the examiner must provide an affidavit or declaration setting forth specific

factual statements and explanation to support the finding." [M.P.E.P. § 2144.03]

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Accordingly, Applicant alternatively requests that the Patent Office provide such an affidavit or declaration to support the Patent Office's findings.

In the ninth section of the Office Action, claims 10, 19, 26, 37 and 46 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Birrell in view of Terui et al. (U.S. Patent No. 5,903,871, hereinafter "Terui"). These rejections are respectfully traversed.

Dependent claims 10, 19, 26, 37 and 46 variously depend from independent claims 1, 11, 22, 38 and 38, and are, therefore, patentably distinguishable over the combination of Birrell and Terui for at least those reasons stated above with regard to independent claims 1, 11, 22, 38 and 38. For example, it is respectfully submitted that Terui does not teach or even suggest the feature of a programmable processor that is programmed as **both a storage controller** to retrieve the compressed media data stored in a storage device **and** a **digital signal processor** to decompress the compressed media data stored in a memory.

Accordingly, reconsideration and withdrawal of these grounds of rejection are respectfully requested.

In the tenth section of the Office Action, claims 1-23, 25, 26, 28-48 and 95-112 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-10 of co-pending Application No. 10/184,302. Claim 1-23, 25, 26, 28-48 and 95-112 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-5, 20-23, 38-41, 56-59 and 74-85 of co-pending Application No. 10/184,299. Claim 1-23, 25, 26, 28-48 and 95-112 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-10, 26-34 and 50-53 of co-pending Application No. 10/184,505.

According to M.P.E.P. § 804,

> [i]f the "provisional" double patenting rejections in both applications are the
> only rejections remaining in those applications, the examiner should then
> withdraw that rejection in one of the applications (e.g., the application with
> the earlier filing date) and permit the application to issue as a patent. The
> examiner should maintain the double patenting rejection in the other
> application as a "provisional" double patenting rejection which will be
> converted into a double patenting rejection when the one application issues as
> a patent. [M.P.E.P. § 804(I)(B)]

Therefore, Applicant acknowledges the provisional obviousness-type double patenting

rejection of claims 1-23, 25, 26, 28-48 and 95-112 of the present application. In accordance

with the mandates of M.P.E.P. § 804, Applicant respectfully notes that when co-pending U.S.

Patent Application Serial Nos. 10/184,302, 10/184,299 and 10/184,505 are issued as

respective patents, and the present provisional rejections are withdrawn and converted to

(non-provisional) obviousness-type double patenting rejections in the present case, Applicant

will address any such (non-provisional) obviousness-type double patenting rejections at such

time.

All of the objections and rejections raised in the Office Action having been addressed,

it is respectfully submitted that the present application is in condition for allowance and a

notice to that effect is earnestly solicited. Should the Examiner have any questions regarding

this amendment or the application in general, the Examiner is urged to contact the

Applicant's attorney, Andrew J. Bateman, by telephone at (202) 625-3547. All

correspondence should continue to be directed to the address given below.

Respectfully submitted,

By: _____

Andrew J. Bateman
Attorney for Applicant
Registration No. 45,573

IP Docket
Katten Muchin Rosenman LLP
1025 Thomas Jefferson St., NW
East Lobby, Suite 700
Washington, DC 20007-5201
Facsimile No.: (202) 298-7570
Customer No.: 28285